

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: SHERRY CHU-HSIN HSU, PRAVEEN K. KOLLI, and
DELMAR MARR

Appeal No. 2008-1905
Application 09/896,255
Technology Center 2400

Mailed: November 20, 2008

Before DALE M. SHAW, *Chief Appeals Administrator*.

SHAW, *Chief Appeals Administrator*.

ORDER REMANDING TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on February 12, 2008. A Docketing Notice was mailed and Appeal No. 2008-1905 was assigned on February 27, 2008. A review of the application has revealed that the application was not ready for an appeal. Accordingly, the application is herewith being remanded to the Examiner. The matter requiring attention is identified below.

APPEAL BRIEF, APPEALED CLAIMS

Appellant has not appealed all rejected claims. Specifically, a review of the Grounds of Rejection on the record finds that rejections are outstanding for the following pending claims: 1-42. The rejected claim that has not been appealed and/or argued for appeal is claim 42.

DISCUSSION

The Board of Appeals and Interferences (Board), in *Ex parte Ghuman*, <http://www.uspto.gov/web/offices/dcom/bpai/prec/rm081175.pdf> (BPAI May 14, 2008) (precedential), held that in appeals where rejected claims are expressly withdrawn, or are implicitly withdrawn by not presenting arguments in support of patentability, the Board will remand (or return) the application to the Examiner with instructions to cancel the expressly or implicitly withdrawn claims. *See also Manual of Patent Examining Procedure* (MPEP) § 1215.03 (8th ed. Rev. 6, Sept 2007).

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to enter a paper canceling claim 42; and

Appeal No. 2008-1905
Application No. 09/896,255

2) upon entry of the paper, to return the application to the Board for
the consideration of appealed claims;

3) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the
Board of Patent Appeals and Interferences at 571-272-9797.

LAE

REDWOOD PATENT LAW
1291 EAST HILLSDALE BOULEVARD
SUITE 205
FOSTER CITY, CA 94404